REMARKS

The Office Action dated October 5, 2006, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto. Claims 1-46 are currently pending in the application, of which claims 1 and 24 are independent claims. Claims 1-46 are respectfully submitted for consideration.

Claims 1-46 were previously rejected under 35 U.S.C. 102(b). Presently, claims 1-46 have been rejected under 35 U.S.C. 102(e) on the basis of the same reference. However, the new rejection was not necessitated by Applicants' amendments. Nevertheless, the Office Action was designated as "Final." Withdrawal of the finality of the Office Action is respectfully requested, because it contains a new rejection that was not necessitated by amendment.

Claims 1-46 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,850,521 of Kadambi et al. ("Kadambi"). Applicants respectfully traverse this rejection.

Claim 1, upon which claims 2-23 depend, is directed to a method of handling data packets in a network device. The method includes receiving an incoming data packet. The method also includes parsing the incoming data packet to obtain a portion of the incoming data packet. The method further includes comparing said portion with rules stored in a rule table, where each rule of said rules specifies a set of actions. The method additionally includes selecting a match between said portion and a particular rule of said

rules. The method also includes executing a particular set of actions specified by said particular rule. Each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule.

Claim 24, upon which claims 25-46 depend, is directed to a network device for handling data packets. The device includes a rules table, means for receiving an incoming data packet, means for parsing the incoming data packet to obtain a portion of the incoming data packet, and means for comparing said portion with rules stored in said rule table, where each rule of said rules specifies a set of actions. The device also includes means for selecting a match between said portion and a particular rule of said rules and means for executing a particular set of actions specified by said particular rule. Each rule field of said rules includes a mask and a selection flag used by the means for comparing said portion with each rule.

Applicants respectfully submit that Kadambi does not disclose or suggest all of the elements of any of the presently pending claims.

Kadambi generally relates to a network switch. Kadambi, at column 13, lines 55-57, indicates that Ethernet data can be considered to arrive at one of the ports 24a of the Ethernet port interface controller 20a. At column 30, lines 54-56, Kadambi indicates that the arrival of the first sixty-four bytes of a packet can trigger a filtering request being sent to FFP 141. Kadambi goes on to explain that FFP 141 is essentially a state machine driven programmable rules engine, at column 31, lines 20-24. The filters of the FFP 141 can be sixty-four bytes wide and can be applied to an incoming packet. Kadambi

mentions that a sixty-four byte filter mask can be used and applied to any sixty-four bytes of a packet.

Moreover at column 31, lines 50-57, Kadambi notes that SOC 10 includes a filter database that contains multiple filter sets. Two sets of filters can be provided, each containing eight filters and an associate rules table 512 entries deep. The specifics of the filter mask are set forth at column 31, line 58, to column 33, line 13.

As Kadambi explains at column 33, lines 29-33, logic 1411 goes through all filters that have an enable bit set and applies the mask-portion of the filter to the field. The result of that operation is concatenated with the filter number to generate a search key. For example, as illustrated at column 33, lines 55-58, a key can be used to sort the entries in the rule table with "filter value + egress port + egress module + egress module + ingress port + filter select" as the key.

Claims 1 and 24 each recite "wherein each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule." Applicants respectfully submit that Kadambi does not disclose or suggest at least this portion of the claimed invention.

The Office Action cited Kadambi at column 33, lines 35-41 and 55-58. The cited passage, however, does not mention either a "mask" or a "selection flag." The Office Action construed Kadambi's "key" as corresponding to the claimed "mask," and Kadambi's "filter select" as corresponding to the claimed "selection flag."

Kadambi, however, does not indicate that its key functions as a mask, nor has the Office Action provided any analysis to explain how a key can function as a mask. Instead, as explained above, Kadambi does provide a filter mask explained at column 31, line 58, to column 33, line 13. Kadambi's search key, however, is not part of that mask. Thus, it is clear that Kadambi's search key does not correspond to the claimed mask.

Furthermore, claims 1 and 24 recite "a mask ... used in the comparing said portion with each rule." Even if the search key were a mask (not admitted) it is not used in the comparing of a portion of a packet to rules. Instead, as explained at column 33, lines 55-58, the key described there is used to sort entries in the rules table, and as explained at column 33, lines 33-35, the search key described there is used to search for a match to the key in the rules table, not to compare a portion of a packet with a rule.

Moreover, Kadambi does not indicate that the "filter select" is a "selection flag" and the Office Action did not explain how the "filter select" performs the functions of a "selection flag." Kadambi, in fact, describes that the filter select is combined with the filter value, the egress port, and several other items to provide the key discussed at column 33, lines 55-58.

Accordingly, it is respectfully submitted that Kadambi does not and cannot disclose or suggest all of the features of claims 1 and 24, in particular, at least the feature: "wherein each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule." Accordingly, it is respectfully requested that the rejection of claims 1 and 24 be withdrawn.

Claims 2-23 and 25-46 depend from claims 1 and 24 and recite additional limitations. It is, therefore, respectfully submitted that claims 2-23 and 25-46 recite subject matter that is neither disclosed nor suggested in Kadambi. Thus, it is respectfully requested that the rejection of claims 2-23 and 25-46 be withdrawn.

The Office Action, in the "Response to Arguments" section, took the position that Kadambi discloses "wherein each rule field of said rules includes a mask and a selection flag used in the comparing said portion with each rule." The Office Action took the position that the "key" used in Kadambi is a mask, and that "filter select" used in Kadambi is a selection flag, citing Kadambi at column 33, lines 35-41 and 55-58. Applicants respectfully disagree.

The Office Action does not have any basis in either Kadambi or the present application for taking the position that the "key" used in Kadambi is a mask, and that "filter select" used in Kadambi is a selection flag.

Kadambi does use the term of art "mask" but does not apply it to the key used by Kadambi. See, for example, the Abstract of Kadambi, claim 8 of Kadambi, and claim 35 of Kadambi. Claim 35 of Kadambi is particularly instructive, because it states: "wherein said step of applying at least one mask to a field value comprises: applying a predetermined number of offsettable masks to the packet to generate a predetermined number of sub-fields; and concatenating the sub-fields to generate a packet key." (emphasis added)

As can be seen from claim 35 of Kadambi, Kadambi clearly distinguishes between a "mask" and a "key." The key Kadambi discusses in claim 35 is the result of the concatenation of subfields generated by the application of a predetermined number of masks. Thus, as Kadambi uses the words, a "key" and a "mask" are not the same thing. Thus, it is respectfully submitted that the Office Action's position that a "key" is a "mask" is not supported by evidence of record.

The Office Action appears to have acknowledged that the key is the result of the application of a mask to a field, but for no apparent reason then concludes that the key is therefore "logically equivalent to a mask." Applicants respectfully submit that this argument is flawed. Reducing the argument to symbolic terms, the argument becomes: A is produced by B, and therefore B is logically equivalent to A. If one substitutes "milk" for A and "cow" for B, the fallacy of the argument is readily apparent ("Milk is produced by a cow, and therefore a cow is logically equivalent to milk"). Such a position is obviously mistaken. The Office Action's argument substitutes "key" for A and "mask" for B, and has the same logical flaw of conflating the product with the thing that produces it. Accordingly, Applicants respectfully submit that the Office Action's position that the "key" (produced by a process that includes a mask) is logically equivalent to a mask is logically invalid. It is, therefore, respectfully requested that the rejection be withdrawn.

Although the Office Action maintained the position that Kadambi's "filter select" is equivalent to the claimed "selection flag," it does not explain why, except to say that the filter select is three bits long and is used to identify the filter number, which is used to

match the entries. Applicants respectfully submit that the length of Kadambi's "filter select" is irrelevant. Applicants respectfully submit that Kadambi's "filter select" may be used to match entries, but it is, nevertheless, not a "selection flag," as claimed. The Office Action's position seems to make the term "selection flag" itself meaningless, and focus instead on the configuration of the claimed selection flag "used in the comparing said portion with each rule." The Office Action is not permitted to ignore the words used in the claims.

MPEP 2106 states "Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (en banc), aff'd, U.S., 116 S. Ct. 1384 (1996). Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art.")." However, in the present rejection, the meaning of "selection flag" is being essentially ignored, because the Office Action's position makes the term "selection flag" meaningless.

Furthermore, MPEP 2173.01 states that a "fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can

define in the claims what they regard as their invention essentially in whatever terms they choose so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought." However, in the present case, the Office Action is essentially denying Applicants' right to define the invention using the term "selection flag" by ignoring the meaning of that term.
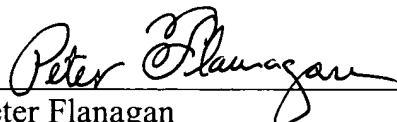
Additionally, MPEP 2131 states that "TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM" (caps in original). This principle has been stated by the Federal Circuit: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). However, the Office Action essentially does not address the element "selection flag" because it essentially took the position that because Kadambi's "filter select" is used in a similar way to the way that claimed "selection flag" is used, that it is therefore the same feature. Accordingly, for this additional reason, it is respectfully requested that the rejection be withdrawn.

For the reasons explained above, it is respectfully submitted that each of claims 1-46 recite subject matter not disclosed or suggested by Kadambi. It is, therefore, respectfully requested that each of claims 1-46 be allowed, and that this application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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